

REMARKS

1. STATUS OF CLAIMS

Prior to this amendment, Claims 1-9, 11-17, 19 and 21-27 were pending in the application. In an office action dated January 21, 2003, each claim was rejected under 35 USC §103(a) as being unpatentable over Goldberg et al. (U.S. Patent No. 6,183,366 hereinafter Goldberg) in view of Titmuss et al. (WO 98/47295 hereinafter Titmuss).

The present amendment cancels claim 3 and 14. Claim 1 was amended to add the limitations of claim 3. Claim 13 was amended to add the limitations of claim 14. A clean version of the amended claims in APPENDIX A.

2. SUMMARY OF INVENTION

The demand for services has increased for wireless communication systems. The cost of these services, however, still remains high for many individual subscribers for many services. There is a need for alternative service offerings of network providers to enable better usage on the wireless communication network. The present invention is directed to satisfying that need.

In particular, independent claim 1 is directed to a method of providing service in a wireless communication network. The steps include: providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network; providing products or services to said end user in response to a subscription to one of said service options; and providing advertisements to the end user in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a content that a user is receiving on said wireless communication device. [See, e.g., Application, p. 19, lines 1-26; p. 30, line 26 – p. 31, line 6] Claim 1 was further amended to include the recitation that the advertisements are based upon location related information of the wireless communication device where the location related information includes at least one of the following – direction or speed. [See, e.g., old claim 3 and Application, p. 19, lines 9-12; p. 20, lines 10-20; p. 24, lines

19-27; p. 30, lines 9-14] These features allow the system to track the location of the particular user at a time and over time. The advertisement can then be delivered to the user when the system decides to deliver the advertisement. For example, the advertisement may be delivered when the user is approaching an outlet.

Independent claim 13 recites the steps of providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network, providing products or services to said end user in response to a subscription to one of said service options, and providing advertisements to the end user in lieu of receiving compensation for the subscription. However, in claim 13, the provision of the advertisements are based upon a configuration of the wireless communication device. [See, e.g., Application, p. 20, lines 10 – p. 22, line 23] Claim 13 was further amended to include the recitation that the method further include the step of requiring user interaction to determine whether an advertisement was reviewed. [See, e.g., old claim 14 and Application, p. 19, lines 9-26; p. 21, line 22 – p. 22, line 2; p. 30, lines 9-14] These features provide important feedback on whether the users are viewing the advertisements.

Independent claim 27 is similar to claim 13 and is directed to a method where the wireless communication device is in a vehicle. The method includes, among other things, the step of providing advertisements to the end user in lieu of receiving compensation wherein the advertisements are based upon the status of sensors in a vehicle incorporating the wireless communication device. [See, e.g., Application, p. 23, lines 1-22]

4. ISSUES

Issue 1

Whether claims 1, 2, 4-9, 11-13, 15-17, 19, and 21-27 are unpatentable under 35 USC §103(a) over Goldberg et al. (US 6,183,366) in view of Titmuss et al. (WO 98/47295).

5. ARGUMENT

(i) *Rejections under 35 USC §103(a):*

Claims 1-9, 11-17, 19 and 21-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldberg et al. (U.S. Patent No. 6,183,366 hereinafter Goldberg) in view of Titmuss et al. (WO 98/47295 hereinafter Titmuss). Claims 1, 13 and 27 are independent claims. Claim 1 was amended to add the limitations of claim 3. Claim 13 was amended to add the limitations of claim 14. Accordingly, claims 3 and 14 have been cancelled. The rejection of the foregoing claims is respectfully traversed for the following reasons.

There exists a significant distinction in the art between these prior art references and the presently claimed invention. Goldberg describes a method and apparatus for automating the playing of games such as blackjack to users on the Internet. [Col. 1, lines 17-20] There is an embodiment that describes enhanced features for presenting sponsor or advertiser information that match player profiles over the Internet. [Col. 21, lines 58-63; Col. 29, lines 7-20] Goldberg does not teach a wireless communication device. Moreover, Goldberg does not teach the providing of advertisements to the end user in lieu of receiving compensation for a subscription where the advertisements are based upon the content that a user is receiving on the wireless communication device.

Additionally, with regard to independent claim 1, Goldberg does not teach that the advertisements are based upon location related information of the wireless communication device, the location related information including at least direction or speed. There is no suggestion that Goldberg would have these features since that system does not include any type of location or direction type sensors but rather simply hard lined into the Internet.

Further, with regard to independent claim 13, Goldberg does not teach or suggest the step of requiring user interaction to determine whether an advertisement was reviewed and considered an advertisement that was provided in lieu of receiving

compensation for the service. In contrast, Goldberg is distinguishable because it discusses only making sure a view add feature is running, but does not discuss at all any two way interaction. The inclusion of feedback is a significant addition to the claimed system.

Titmuss describes a method of delivering information to mobile users in a telecommunication system. Titmuss does discuss the transfer of information based on the format type supported by a terminal. Titmuss, however, does not make up the deficiencies in Goldberg. For example, with regard to claim 1, Titmuss does not teach or suggest at least the providing of advertisements based upon location related information of the wireless communication device where the location related information includes at least direction or speed. Titmuss is silent as to advertisements and how they could be provided to an end user in relation to compensation for subscription fees. In fact, it appears that Titmuss teaches that a fee is imposed for the system. [Titmuss, Page 21, lines 12-13 (“Each personal agent may periodically report use of the services available to a billing system for billing purposes.”)] With regard to claim 13, Titmuss does not teach or suggest at least the step of requiring user interaction to determine whether an advertisement was reviewed and considered an advertisement that was provided in lieu of receiving compensation for the service. Titmuss appears to be related to a much more complex system where a user has access to many types of terminals and the ability of the user to select or access information from those terminals depending on the file type.

With regard to independent claim 27, the office action does not specifically address the added limitations in claim 27 but simply refers to the discussion relating to claims 12 and 13 (just like the final rejection and a prior office action previously received). Claim 27, however, ***recites that the step of providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device***. None of the cited references (Goldberg or Titmuss) discuss or make any mention of vehicle sensors much less advertisements based upon such vehicle sensors. The applicant respectfully requests for identification of where this feature is located in the cited references.

In sum, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In other words, the prior art references (separately ***and in combination***) fail to teach or suggest all of Appellants’ claimed limitations, as required for a 35 USC §103(a) rejection. MPEP706.02(j). Namely, with regard to claim 1 (and its dependent claims), none of the references teaches at least the step of providing of advertisements based upon location related information of the wireless communication device where the location related information includes at least direction or speed. With regard to claim 13, none of the references teaches at least the step of requiring user interaction to determine whether an advertisement was reviewed and considered an advertisement that was provided in lieu of receiving compensation for the service. Additionally, with respect to independent claim 27, none of the references teaches the additional step of providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device.

Claims 2, 4-9, 11, 12, 21, 22 depend on independent claim 1. Claims 15-17, 19, 23-26 depend on independent claim 13. These dependent claims are believed to be allowable for at least the same reasons discussed above. *See In re Fine*, 837 F.2d 1071, 1076, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.). Some of these dependent claims are further discussed below.

With regard to claim 12, the last office action (as well as the final rejection and the original office action) do not specifically address the added limitations in claim 12. Claim 12 depends on claim 1, and recites that the step of providing advertisements further includes providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device. None of the cited references (Goldberg or Titmuss) discuss or make any mention of vehicle sensors much less advertisements based upon such vehicle sensors.

Claims 9 and 17 depends on claims 1 and 13, respectively, and recite that the step of providing advertisements further includes providing advertisements based upon advertisement acceptance. This is shown and described in the application with relation to Figure 7 where advertisement acceptance (558) is fed into an information pool so that the claimed method can provide advertisements based on such information. The cited references fail to provide this specific feature in the wireless communication network as taught and claimed in the present application. Deficiencies of the cited references (Goldberg or Titmuss) cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art).

Claim 6 depends on claims 1 and recites that the method include a further step of requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service. The last office action cites the Goldberg reference. Goldberg is distinguishable because it discusses only making sure a view add feature is running, but does not discuss at all any two way interaction. The inclusion of feedback is a significant addition to the claimed system.

Claims 7 and 15 depend on claims 1 and 13, respectively. Claims 8 and 16 depend on claims 1 and 13, respectively. These claims recite that the step of providing advertisements comprises providing advertisements when a vendor has a product on an end user's shopping list and providing advertisements based upon a shopping history of the end user. The last office action cites pages 14 and 19 of Titmuss for the proposition that it teaches the advertisements are based upon a shopping list of the user. The Applicants are unable to find any reference to advertisements or shopping lists on these pages of Titmuss. Accordingly, it does not appear that Titmuss is appropriate to cite as prior art to these claims.

The Applicants respectfully request withdrawal of the obviousness rejection based on these references.

CONCLUSION

For the above reasons, it is respectfully submitted that the Examiner reconsider the rejection of the claims under 35 USC §103(a) as being unpatentable over Goldberg et al. in view of Titmuss, and the claims be allowed. If the Examiner is of the opinion that any issues regarding the status of the claims remain after this reply, the Examiner is invited to contact the undersigned representative to expedite resolution of the matter. Furthermore, please charge any additional fees (including extension of time fees), if any are due, or credit overpayment to Deposit Account No. 52117.

Respectfully Submitted,
STEELE ET AL.

by: 

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APPENDIX A
Version with Markings to Show Changes Made

IN THE CLAIMS

Claim 3, 14 has been cancelled.

Claims 1 and 13 have been amended as follows:

1. A method of providing service in a wireless communication network comprising the steps of:

providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network;

providing products or services to said end user in response to a subscription to one of said service options; and

providing advertisements to the end user in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a content that a user is receiving on said wireless communication device;

wherein the advertisements are based upon location related information of said wireless communication device, said location related information includes at least one of the following: direction or speed.

3. (CANCELLED)

13. A method of providing service in a wireless communication network comprising the steps of:

providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network;

providing products or services to said end user in response to a subscription to one of said service options; ~~and~~

providing advertisements to the end user in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a configuration of said wireless communication device; and

requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service.

14. (CANCELLED)